

### REMARKS

Claims 1-26, 28-38, and 40-58 constitute the pending claims in the present application. Applicants have corrected the names of many of the compounds recited in the claims and specification. Applicants submit that one of skill in the art would have recognized, in light of the depicted structures and corresponding experimental protocols, that the subject compounds should have been originally given the corrected names now submitted. Briefly, an 'amido' substituent is attached via its nitrogen atom, which is acylated. In contrast, an 'aminocarbonyl' substituent is attached via its carbonyl. It is the latter substituent that would result from the reactions described in the specification. The error in the name of CR29 results not from a misapprehension of the compound's geometry, which is correct as depicted, but from a mistaken prioritization of the alkene substituents (the cyano group has a higher priority than the aminoethene group, making the second alkene Z). Thus, no new matter is being added. Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the prior Office Action.

1-2. Claim 39 is rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants have cancelled claim 39, thereby rendering this rejection moot. Applicants reserve the right to prosecute claims of similar or differing scope in subsequent applications.

3-4. Claims 36-39 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Applicants have amended these claims as suggested by the Examiner to overcome this rejection. Applicants submit that the scope of these claims is not narrowed by this amendment. Reconsideration and withdrawal of this rejection are respectfully requested.

The Office Action asserts that claims 25 and 26 "cover the same thing." Applicants have amended claim 26 to overcome this objection. Reconsideration and withdrawal of this rejection are respectfully requested.

5-6. Claims 1-3, 9, 10, and 21-23 are rejected under 35 U.S.C. §102(b) as being anticipated by EP 0335,641 or US 4,950,467. Applicants respectfully traverse this rejection to the extent it is maintained over the claims as amended.

Claim 1 as amended is directed to a pharmaceutical composition suitable for oral, intravenous, intraperitoneal, subcutaneous, intramuscular, nasal, intrapulmonary, intrathecal, or rectal administration. Applicants submit that the cited art, which disclose sunscreen lotions and non-linear optical materials, neither teach nor suggest such compositions, no less compositions that meet the other criteria set forth in the claims. Accordingly, Applicants request that this rejection be withdrawn.

With respect to the newly added claims directed to compounds, Applicants point out that claims 52 and 53 have refined definitions of R<sup>5</sup>, claim 54 relates to compounds of Formula II, and claims 55, 56, and 57 recite particular substituents for the phenyl ring of Formula I. Applicants further point out that compound 394 of Pruett et al., cited by the Examiner in paragraph 9 (addressed in greater detail below) has an ethyl group at position 3 of the phenyl ring, which corresponds to a hydrogen position of the structure set forth in the pending claims, and thus does not fall within the scope of any of the recited structures.

7-9. Claims 1-3, 6-12, 21-23, and 27 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over EP 235,198 or EP 335,641 or JP 3230127 or US 4,950,467. Claim 27 has been cancelled, thereby rendering this rejection moot with respect to that claim. Applicants respectfully traverse this rejection to the extent it is maintained over the remaining claims as amended.

Applicants submit that the reasoning set forth above with respect to the rejection under 35 U.S.C. § 102(b) applies with equal force to the rejection under 35 U.S.C. § 103(a). To establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. And third, there

must be a reasonable expectation of success. (MPEP 2143) Specifically, none of these references teach or suggest the full complement of the limitations in the any of the pending claims. Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 21-23 are further objected to for containing identical species. Although Applicants submit that claims of overlapping but differing scope are entirely proper, Applicants have nonetheless amended claims 22 and 23 to obviate the issue raised by the Examiner.

10. Applicants note with appreciation that claims 4-5, 13-26, and 40-43 would be allowable if rewritten in dependent form.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Date: July 10, 2003

**Customer No: 28120**  
Docketing Specialist  
Ropes & Gray  
One International Place  
Boston, MA 02110  
Phone: 617-951-7000  
Fax: 617-951-7050

Respectfully Submitted,



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David P. Halstead  
Reg. No. 44,735